

REMARKS/ARGUMENTS

Claim Objections

The Examiner has objected to claims 8, 9 and 21. Applicants have amended claim 1 to set forth the full chemical names for the 5-CNAC, SNAD and SNAC acronyms. Thus, the abbreviations 5-CNAC, SNAD and SNAC first occur with their complete chemical names.

Accordingly, Applicants respectfully request withdrawal of the outstanding claim objections.

Applicants have canceled claim 21, rendering this objection moot.

Claim Rejections

Rejections under 35 U.S.C. § 112

The Examiner has rejected pending claims 1-2, 5-6 and 9-10 as allegedly lacking enablement for preventing osteoarthritis, administering calcitonin to any patient, and using any calcitonin. Solely in order to expedite prosecution, claim 1 has been amended to clarify that the method is directed to treatment. Claim 2 has been amended to indicate that the patient is one having osteoarthritis or osteoporosis, or the method is directed to inhibiting resorption and/or normalizing turnover of subchondral bone in a postmenopausal woman. Both independent claims 1 and 2 clarify that the calcitonin is salmon calcitonin.

For at least these reasons, Applicants respectfully submit that all pending claims satisfy 35 U.S.C. § 112, and therefore respectfully request withdrawal of the enablement-based rejection of the pending claims.

Rejections under 35 U.S.C. § 102

The Examiner has rejected pending claims 1-2, 6 and 9-10 as allegedly lacking novelty over Bay et al. (US20020065255). Solely in order to expedite prosecution, independent claims 1 and 2 have been amended to recite the dosage found in previously pending (and now canceled) claim 22. As Bay et al. does not disclose or suggest this dosage, Bay et al. does not anticipate independent claims 1 and 2 or their dependents.

The Examiner has rejected pending claims 1-2, 5-6 and 10 as allegedly lacking novelty over Ghirri et al. (US6352974). Solely in order to expedite prosecution, independent claims 1 and 2 have been amended to recite a delivery agent selected from 5-CNAC, SNAD, SNAC and disodium salts thereof, which element was previously found in pending (and now canceled) claims 8 and 9. As Ghirri et al. does not disclose or suggest these delivery agents, Ghirri et al. does not anticipate independent claims 1 and 2 or their dependents.

For at least these reasons, Applicants respectfully submit that all pending claims satisfy 35 U.S.C. § 102, and therefore respectfully request withdrawal of the novelty-based rejection of the pending claims.

Double Patenting

Pending claim 2 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over claims 1, 9 and 10 of copending Application No. 11/577,127.

Pending claims 1-2 and 10 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over claims 13-15 of copending Application No. 12/132,642.

Pending claims 1-2 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over claims 26, 28 and 29 of copending Application No. 12/093,383.

The present application is further along in prosecution than the above-identified co-pending applications. Applicants therefore respectfully request that upon allowance of the claims under consideration in this application, the Examiner withdraw the double patenting rejection in this application, and make a provisional double patenting rejection in the above-identified co-pending applications. The provisional rejection in the above-identified co-pending applications may then be converted into a double patenting rejection upon the present application issuing into a patent. See MPEP 804.

CONCLUSION

In light of the above amendments, observations and remarks, Applicants respectfully submit that the presently claimed invention satisfies 35 U.S.C. §112, and is neither disclosed nor suggested by any art of record. Accordingly, reconsideration and allowance of all claims in this application is earnestly solicited.

Applicants' undersigned attorney may be reached in our New Jersey office by telephone at (862) 778-9308. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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